

REMARKS

Claims 2 through 36 are pending in this application, of which claims 5, 7 through 31, 35 and 36 stand withdrawn from consideration pursuant to the provisions of 37 C.F.R. § 1.142(b). Accordingly, claims 2 through 4, 6 and 32 through 34 are active.

Claim 1 has been cancelled, claim 2 placed in independent form by incorporating the limitations of claim 1 therein, and the dependency of claims 3, 4, 6, 32 and 34 appropriately changed. Applicants submit that the present amendment does not generate any new matter issue.

Claims 1 through 4, 6 and 32 were rejected under 35 U.S.C. § 102 for lack of novelty as evidenced by Hiroshi.

In the statement of the rejection the Examiner made certain findings as to the teachings of Hiroshi and then determined that Hiroshi discloses a level conversion circuit corresponding to that claimed. This rejection is traversed.

The factual determination of lack of novelty under 35 U.S.C. § 102 requires the **identical** disclosure in a single reference of each element of a claimed invention, such that the **identically** claimed invention is placed into the recognized possession of one having ordinary skill in the art. *Dayco Prods., Inc. v. Total Containment, Inc.*, 329 F.3d 1358, 66 USPQ2d 1801 (Fed. Cir. 2003); *Crown Operations International Ltd. v. Solutia Inc.*, 289 F.3d 1367, 62 USPQ2d 1917 (Fed. Cir. 2002). In imposing a rejection under 35 U.S.C. § 102 the Examiner is required to specifically identify wherein an implied reference is believed to **identically** disclose each and every feature of a claimed invention, particularly where such is not apparent as in the present case. *In re Rijckaert*, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481 (Fed.

Cir. 1984). That burden has not been discharged. Indeed, there are significant differences between the claimed level conversion circuit and Hiroshi's circuit that scotch the factual determination that Hiroshi discloses a level conversion circuit identically corresponding to that claim.

Specifically, the Examiner erred in determining that the segment represented by (reference "A") in Fig. 1 of Hiroshi is equivalent to the "output node" required by independent claim 2. This determination is not accurate, because claim 2 requires that "... an output signal is obtained from the output node"; whereas, such an output signal cannot be obtained from the element represented by "A" illustrated in Fig. 1 of Hiroshi. Therefore, as a factual matter, Hiroshi neither discloses nor suggests the **"output node" and the related features of the first transistor and second transistor as set forth in independent claim 2.**

The above argued differences between the claimed level conversion circuit and Hiroshi's circuit undermine the factual determination that Hiroshi discloses a level conversion circuit identically corresponding to that claim. *Minnesota Mining & Manufacturing Co. v. Johnson & Johnson Orthopaedics Inc.*, 976 F.2d 1559, 24 USPQ2d 1321 (Fed. Cir. 1992); *Kloster Speedsteel AB v. Crucible Inc.*, 793 F.2d 1565, 230 USPQ 81 (Fed. Cir. 1986). Applicants, therefore, submit that the imposed rejection of claims 1 through 4, 6 and 32 under 35 U.S.C. § 102 for lack of novelty as evidenced by Hiroshi is not factually viable and, hence, solicit withdrawal thereof.

Claims 1 through 4, 6, 32 and 33 were rejected under 35 U.S.C. § 102 for lack of novelty as evidenced by Nakano.

In the statement of the rejection the Examiner made certain factual findings as to the perceived teachings of Nakano and then determined Nakano discloses a level conversion circuit corresponding to that claim. This rejection is traversed.

Again, the factual determination of lack of novelty under 35 U.S.C. § 102 requires the **identical** disclosure in a single reference of each element of a claimed invention, such that the **identically** claimed invention is placed into the recognized possession of one having ordinary skill in the art. *Dayco Prods., Inc. v. Total Containment, Inc., supra*, *Crown Operations International Ltd. v. Solutia Inc., supra*. As also previously pointed out, in imposing a rejection under 35 U.S.C. § 102 the Examiner is required to specifically identify wherein an applied reference is believed to **identically** disclose each and every feature of a claimed invention, particularly where such is not apparent as in the present case. *In re Rijckaert, supra*; *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co., supra*. That burden has not been discharged. Indeed, there are fundamental differences between the claim level conversion circuit and Nakano's circuit that scotch the factual determination that Nakano discloses a level conversion circuit identically corresponding to that claimed.

Specifically, claim 2 is directed to a level conversion circuit requiring, *inter alia*, that:

control electrodes of first and second transistors connected in a specified manner;

an output signal is obtained from the output node;

the signal supply voltage is set for the first and second transistors or the different supply voltages are separately set for the first and second transistors;

the supply voltage which corresponds to the first transistor is set to a higher value than the high level of the input signal and the supply voltage which corresponds to the second transistor is set to a higher value than the high level of the input signal;

the degree of ONE status of the first and second transistors is controlled according to a difference between the supply voltages and voltage of the input signal; and wherein the input signal is converted to the output signal corresponding to the supply voltage.

While the Examiner asserts that the above identified features are disclosed, such is not apparent, including the requirement for controlling the ON status according to a difference between the supply voltage and voltage of the input signal. Merely asserting that the above features are disclosed does not make it so.

The above argued differences between the claimed level conversion circuit and Nakano's circuit undermine the factual determination that Nakano discloses a level conversion circuit identically corresponding to that claimed. *Minnesota Mining & Manufacturing Co. v. Johnson & Johnson Orthopaedics Inc., supra*; *Kloster Speedsteel AB v. Crucible Inc., supra*. Applicants, therefore, submit that the imposed rejection of claims 1 through 4, 6, 32 and 33 under 35 U.S.C. § 102 for lack of novelty as evidenced by Nakano is not factually viable and, hence, solicits withdrawal thereof.

Claim 34 was rejected under 35 U.S.C. § 103 for obviousness predicated upon Nakano.

This rejection is traversed. Specifically, claim 34 depends from independent claim 2. Applicants incorporate herein the arguments previously advanced in traversing the imposed rejection of claim 2 under 35 U.S.C. § 102 for lack of novelty as evidenced by Nakano. The additional comments with respect to claim 34 do not cure the previously argued deficiencies of Nakano. Accordingly, even if Nakano's circuit is modified as suggested by the Examiner, and Applicants do not agree that the requisite fact-based motivation has been established, the claimed

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invention will not result. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988).

Applicants, therefore, submit that the imposed rejection of claim 34 under 35 U.S.C. § 103 for obviousness predicated upon Nakano is not factually legally viable and, hence, solicit withdrawal.

Based upon the foregoing it should be apparent that the imposed rejections have been overcome and that all active claims are in condition for immediate allowance. Favorable consideration is, therefore, solicited.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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